

## REMARKS

### *Status of the claims*

Claims 36-121 are pending in the application. Claims 1-35 were cancelled. By virtue of this response, claims 36, 42, and 47 are amended; and new claims 122-144 are added. Accordingly, claims 36-144 are currently under consideration. Support for new claims 122-129 is found in the specification on, *inter alia*, page 12, lines 25-29; and page 13, lines 16-20.

With respect to all claim amendments and cancellations, Applicant has not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections and/or objections made by the Patent Office. Applicant reserves the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional application.

### *Allowable subject matter*

Applicant thanks the Examiner for acknowledging that claims 36-41, 43-46, and 49-121 are allowable provided that double patenting issues are resolved.

### *Information Disclosure Statement*

Applicant thanks the Examiner for having considered Information Disclosure Statement filed on 11/26/03. Applicant notes that a supplemental Information Disclosure Statement was submitted on September 3, 2004. Applicant respectfully requests the Examiner consider the references and initial the form 1449.

### *Telephone interview*

Applicant thanks the Examiner for extending the courtesy for a telephone interview on August 4, 2004, with Applicant's representative Jie Zhou and for providing helpful suggestions, which are reflected in this response. During the telephone interview, statutory double patenting rejection raised in the Office Action was discussed. As stated in the Interview Summary provided

by the Patent Office dated August 5, 2004, the Examiner agreed that claims 42 and 47 in the present application are not identical to claims 7 and 12 of U.S. Pat. No. 6,346,415 after determining one embodiment that falls within the scope of claims 42 and 47 of the present claims but not claims 7 and 12 of U.S. Pat. No. 6,346,415.

### ***Double Patenting***

Claims 42 and 47 are rejected under 35 U.S.C. 101 for allegedly claiming the same invention as that of claims 6 and 12 of prior U.S. Patent No. 6,346,415.

Applicant respectfully traverses this rejection. Claims 42 and 47 of the present application do not claim the same invention as that of claims 7 and 12 of U.S. Pat. No. 6,346,415. Applicant notes that the Examiner, during the interview, acknowledged that the rejection was made to claim 7 of U.S. Pat. No. 6,346,415, not claim 6 which is a typographical error. As the Examiner pointed out during the telephone interview, a statutory double patenting would not exist if there is an embodiment of the invention that falls within the scope of one claim but not the other. *See*, MPEP §804IIA. Applicant respectfully notes that a polynucleotide comprising an region containing an AAV ITR and five heterologous transcriptionally active elements incorporated 3' with respect to the ITR is within the scope of claims 42 and 47 in the present application, and this polynucleotide is not within the scope of claims 7 and 12 of U.S. Pat. No. 6,346,415, which require four or fewer heterologous transcriptionally active elements. The Examiner had agreed (as stated in the Interview Summary) that claims 42 and 47 are not identical to claims 7 and 17. Accordingly, Applicant respectfully requests withdrawal of this rejection.

Claims 36-41, 43-46, 48-51, 64-70, 89-91, 99, 104, 107, 108, 113-115 are rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-35 of U.S. Patent No. 6,346,415.

Without acquiescence to the rejection and in the interest of expediting prosecution, Applicant notes that a terminal disclaimer over U.S. Pat. No. 6,346,415 is filed with this amendment. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claims 52-63, 71-88, 92-98, 100-103, 105, 106, 109-112, 116-121 are rejected under the judicially created doctrine of double patenting as allegedly being unpatentable over claims 1-35 of U.S. Patent No. 6,346,415.

Without acquiescence to the rejection and in the interest of expediting prosecution, Applicant notes that a terminal disclaimer over U.S. Pat. No. 6,346,415 is filed with this amendment. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

In view of the above, Applicant respectfully requests withdrawal of the above double patenting rejections.

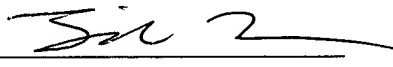
**CONCLUSION**

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejection of the claims and to pass this application to issue. If it is determined that a telephone conference would expedite the prosecution of this application, the Examiner is invited to telephone the undersigned at the number given below.

In the event the U.S. Patent and Trademark office determines that an extension and/or other relief is required, applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952 referencing docket no. 226272003802. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: September 17, 2004

Respectfully submitted,

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